

Attorney Docket No.: LEAP:126US
U.S. Patent Application No. 10/721,695
Reply to Office Action of April 17, 2007
Amendment Dated: June 18, 2007

Remarks/Arguments

The Rejection of Claims 2, 4-6, 8, 11, and 16-21 Under 35 U.S.C. § 103(a)

The Examiner rejected Claims 2, 4-6, 8, 11, and 16-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,018,415 (*Woo*) in view of Leitz Service “Ergolux B 0 1-Ersatztelliste” (the *Leitz Service Manual*). Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

As Examiner is aware, although limitations from the specification can not be read into the claims, the “[c]laims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation.’” M.P.E.P. § 2111.01 quoting *In re Marosi*, 710 F.2d 799, 802 (Fed. Cir. 1983) (emphasis in original). Therefore, Applicants courteously submit that in determining the broadest reasonable interpretation for independent Claims 2, 16 and 17, the disclosure in the specification must also be taken into account.

For example, Applicants described that:

“[D]ue to the variety of microscopists using these instruments, both left and right-handed stages are required. The location of the stage control mechanism is on the side of the stage matching the user’s predominant hand of use. Having to match the stage configuration to the microscopist’s predominate hand creates difficulty during manufacture of products. Each microscope must be either a left-handed or a right-handed microscope. After the assembly is complete, changing the configuration requires significant disassembly and reassembly time, as well as requiring a complete additional stage mechanism. This problem also requires microscope manufacturers to maintain inventories of both left-handed and right-handed stage assemblies.” (Instant Application, Para. [0007]).

Applicants’ invention is directed at solving the above described problem. Thus, Applicants teach the embodiment of Figure 2 “having stage movement means 10 operatively arranged for right-handed use,” and the embodiment of Figure 3 “having [the same] stage movement means 10 operatively arranged for left-handed use.” (Instant Application, Paras. [0026] and [0028]). The present invention “stage assembly is adapted to receive the interchangeable, bidirectional, ergonomic stage assembly movement means,” wherein the “stage movement means can be

operatively arranged in several locations on the stage assembly to allow bidirectional movement of a specimen on the stage. (Instant Application, Para. [0022]) (emphasis added).

Applicants respectfully assert that in view of the disclosure in the specification, the broadest reasonable interpretation for the limitations of “a rod; and, releasable attachment means [] arranged to attach said rod to said slide mount and to operatively position said rod on the left or right side of said upper stage[,]” as recited in Applicants’ Claim 2, is to interpret the limitations to describe a rod which may be positioned on either the left or right side of the stage, *i.e.*, configurable on either side dependant on the predominant hand of the user. Thus, separate sets of parts are not required for both versions, or in other words, a common set of parts may be configured for either left or right handed use. As such, the instant invention microscope stage assembly may be configured in the factory for a particular hand, left or right, and/or end users of the instant invention may modify this arrangement if they desire to use a different hand.

Similarly, Applicants’ Claim 16 recites a “shaft [that] is attachable to said slide mount guide to operatively position said shaft on the left or right side of said upper stage.” Again, Applicants respectfully assert that the broadest reasonable interpretation of Claim 16 includes a shaft that is attachable on either the left or right side of the upper stage and not attachable on only a single side, but attachable on both sides. However, as one of ordinary skill in the art recognizes, the shaft is only attached to one side or the other at any one time.

In like fashion, Applicants’ Claim 17 recites “a joystick detachably secured directly to a slide mount guide **at more than one location** of said slide mount guide, wherein said slide mount guide is connected to said slide mount, and said joystick is attachable to said slide mount guide to operatively position said joystick on the left or right side of said upper stage.” In paragraph [0007] above, the location is described as “the side of the stage matching the user’s predominant hand of use.” Thus, the limitations of Claim 17, when read in view of the specification, set forth an interchangeable microscope stage movement device for providing X and Y movement of a sample comprising a joystick which may be detachably secured to a slide mount guide **at more than one location** of the slide mount guide, *i.e.*, the left or right side of the microscope stage.

Attorney Docket No.: LEAP:126US
U.S. Patent Application No. 10/721,695
Reply to Office Action of April 17, 2007
Amendment Dated: June 18, 2007

Contrarily, Applicants courteously submit that the device taught by *Woo* does not include a releasable attachment means arranged to attach a rod to a slide mount and to operatively position the rod on the left or right side of the upper stage, as recited in Applicants' Claim 2. Additionally, *Woo* fails to teach a stage movement means having a releasable attachment means arranged to releasably attach a shaft to a slide mount guide wherein the shaft is attachable to the slide mount guide to operatively position the shaft on the left or right side of the upper stage, as recited in Applicants' Claim 16. Lastly, *Woo* fails to teach a stage movement device comprising a joystick detachably secured directly to a slide mount guide, and the joystick is attachable to the slide mount guide to operatively position the joystick on the left or right side of the upper stage, as recited in Applicants' Claim 17.

Applicants respectfully assert that *Woo* teaches X-Y table **40** having “[a] joystick **43** ... fixed to the stage ... of the X-Y table **40** of the present invention.” (*Woo*, Col. 5, lines 6 through 7; Figs. 4 and 6). As one of ordinary skill in the art recognizes, the fixed joystick of *Woo* is wholly inadequate to be operatively positioned on the left and right side of X-Y table **40**, as only a single position for joystick **43** is shown and described in *Woo*, *i.e.*, a right handed position, and furthermore, X-axis moving plate **42** does not include any feature capable of permitting the arrangement of joystick **43** in any position other than a right handed position. As such, it is impossible to configure the *Woo* device for left and right handed users, as recited in Applicants' Claims 2, 16 and 17.

Similarly, the *Leitz Service Manual* does not include a releasable attachment means arranged to attach a rod to a slide mount and to operatively position the rod on the left or right side of the upper stage, as recited in Applicants' Claim 2. Additionally, the *Leitz Service Manual* fails to teach a stage movement means having a releasable attachment means arranged to releasably attach a shaft to a slide mount guide wherein the shaft is attachable to the slide mount guide to operatively position the shaft on the left or right side of the upper stage, as recited in Applicants' Claim 16. Lastly, the *Leitz Service Manual* fails to teach a stage movement device comprising a joystick detachably secured directly to a slide mount guide, and the joystick is

Attorney Docket No.: LEAP:126US
U.S. Patent Application No. 10/721,695
Reply to Office Action of April 17, 2007
Amendment Dated: June 18, 2007

attachable to the slide mount guide to operatively position the joystick on the left or right side of the upper stage, as recited in Applicants' Claim 17.

Applicants respectfully assert that the *Leitz Service Manual* discloses upper part 44 having handle 25 secured thereto. (See Figures). As is best shown in the exploded view figure, upper part 44 includes an extended portion on its right side (when viewed from the perspective of a user of the microscope), while the left side of upper part 44 does not include a similar extended portion. Therefore, in short, the stage assembly taught in the *Leitz Service Manual* is only configurable for right handed users. As one of ordinary skill in the art recognizes, the handle of the *Leitz Service Manual* is wholly inadequate to be operatively positioned on the left and right side of upper part 44, as only a single position for handle 25 is shown and described in the *Leitz Service Manual*, i.e., a right handed position, and furthermore, upper part 44 does not include any feature capable of permitting the arrangement of handle 25 in any position other than a right handed position. As such, the *Leitz Service Manual* fails to cure the defects of *Woo*, i.e., it does not teach the limitations missing from *Woo* which are recited in Applicants' Claims 2, 16 and 17. Thus, as “[e]very element of the claimed invention must be literally present arranged as in the claim,” *Woo* in view of the *Leitz Service Manual* fail to teach every element of the claimed invention arranged as in Claims 2, 16 and 17. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added).

In order to establish a *prima facie* case of obviousness, the references alone or in combination must teach or suggest all the limitations of Applicant's claimed invention. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Thus, as independent Claims 2, 16 and 17 each contain at least one element that is not disclosed in the cited references, it generally follows that Claims 2, 16 and 17 are patentable over *Woo* in view of the *Leitz Service Manual*. Dependent Claims 4-6, 8, 11, 18 and 19 contain all of the limitations of independent Claim 2, due to their dependency therefrom. Thus, as Claim 2 is non-obvious in view of *Woo*, and further in view of the *Leitz Service Manual*, due to the missing elements, it necessarily follows that Claims 4-6, 8, 11, 18 and 19 are also non-obvious in view of *Woo*, and further in view of the *Leitz Service Manual*, due to their dependency from Claim 2. Similarly, dependent Claim 20

Attorney Docket No.: LEAP:126US
U.S. Patent Application No. 10/721,695
Reply to Office Action of April 17, 2007
Amendment Dated: June 18, 2007

contains all of the limitations of independent Claim 16, due to its dependency therefrom. Thus, as Claim 16 is non-obvious in view of *Woo*, and further in view of the *Leitz Service Manual*, due to the missing elements, it necessarily follows that Claim 20 is also non-obvious in view of *Woo*, and further in view of the *Leitz Service Manual*, due to its dependency from Claim 16. Dependent Claim 21 contains all of the limitations of independent Claim 17, due to its dependency therefrom. Thus, as Claim 17 is non-obvious in view of *Woo*, and further in view of the *Leitz Service Manual*, due to the missing elements, it necessarily follows that Claim 21 is also non-obvious in view of *Woo*, and further in view of the *Leitz Service Manual*, due to its dependency from Claim 17.

Accordingly, withdrawal of the rejections of Claims 2, 4-6, 8, 11 and 16-21 under 35 U.S.C. § 103(a) is appropriate and respectfully requested.

The Rejection of Claims 3, 9 and 10 Under 35 U.S.C. § 103(a)

The Examiner rejected Claims 3, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Woo* in view of the *Leitz Service Manual* as applied to Claim 2 further in view of U.S. Patent No. 6,049,420 (*Kraft*). Applicants respectfully traverse this rejection for the reasons stated above and the following reasons.

As described *supra*, *Woo* and the *Leitz Service Manual* fail to teach all the elements of Applicants' Claim 2. Furthermore, *Kraft* does not cure the defects of *Woo* and the *Leitz Service Manual* regarding the elements of Claim 2 that are not taught or disclosed by these references, *i.e.*, a releasable attachment means arranged to attach a rod to a slide mount and to operatively position the rod on the left or right side of the upper stage.

Hence, as independent Claim 2 contains elements that are not disclosed in the cited references, it follows that Claim 2 is also patentable over *Woo* in view of the *Leitz Service Manual* and further in view of *Kraft*. Dependent Claims 3, 9 and 10 contain all of the limitations of independent Claim 2, due to their dependency therefrom. Thus, as Claim 2 is non-obvious in view of *Woo* and the *Leitz Service Manual*, and further in view of *Kraft* due to the missing elements, it necessarily follows that Claims 3, 9 and 10 are also non-obvious in view of *Woo* and

Attorney Docket No.: LEAP:126US
U.S. Patent Application No. 10/721,695
Reply to Office Action of April 17, 2007
Amendment Dated: June 18, 2007

the *Leitz Service Manual*, and further in view of *Kraft*, due to their dependency from Claim 2. Applicants request reconsideration and withdrawal of the rejection of Claims 3, 9 and 10.

The Rejection of Claims 7 and 12-14 Under 35 U.S.C. § 103(a)

The Examiner rejected Claims 7 and 12-14 under 35 U.S.C. § 103(a) as being unpatentable over *Woo* in view of the *Leitz Service Manual* as applied to Claim 2 further in view of U.S. Patent Application Publication No. 2003/0169492 (*Nishida et al.*). Applicants respectfully traverse this rejection for the reasons stated above and the following reasons.

Again as described *supra*, *Woo* and the *Leitz Service Manual* fail to teach all the elements of Applicants' Claim 2. Furthermore, *Nishida et al.* do not cure the defects of *Woo* and the *Leitz Service Manual* regarding the elements of Claim 2 that are not taught or disclosed by these references, *i.e.*, a releasable attachment means arranged to attach a rod to a slide mount and to operatively position the rod on the left or right side of the upper stage.

Hence, as independent Claim 2 contains elements that are not disclosed in the cited references, it follows that Claim 2 is also patentable over *Woo* in view of the *Leitz Service Manual* and further in view of *Nishida et al.*. Dependent Claims 7 and 12-14 contain all of the limitations of independent Claim 2, due to their dependency therefrom. Thus, as Claim 2 is non-obvious in view of *Woo* and the *Leitz Service Manual*, and further in view of *Nishida et al.* due to the missing elements, it necessarily follows that Claims 7 and 12-14 are also non-obvious in view of *Woo* and the *Leitz Service Manual*, and further in view of *Nishida et al.*, due to their dependency from Claim 2. Applicants request reconsideration and withdrawal of the rejection of Claims 7 and 12-14.

The Rejection of Claim 15 under 35 U.S.C. § 103(a)

The Examiner rejected Claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Woo* in view of the *Leitz Service Manual* as applied to Claim 2 further in view of U.S. Patent No. 5,907,157 (*Yoshioka et al.*). Applicants respectfully traverse this rejection for the reasons stated above and the following reasons.

Attorney Docket No.: LEAP:126US
U.S. Patent Application No. 10/721,695
Reply to Office Action of April 17, 2007
Amendment Dated: June 18, 2007

Once again as described *supra*, *Woo* and the *Leitz Service Manual* fail to teach all the elements of Applicants' Claim 2. Furthermore, *Yoshioka et al.* do not cure the defects of *Woo* and the *Leitz Service Manual* regarding the elements of Claim 2 that are not taught or disclosed by these references, *i.e.*, a releasable attachment means arranged to attach a rod to a slide mount and to operatively position the rod on the left or right side of the upper stage.

Hence, as independent Claim 2 contains elements that are not disclosed in the cited references, it follows that Claim 2 is also patentable over *Woo* in view of the *Leitz Service Manual* and further in view of *Yoshioka et al.*. Dependent Claim 15 contains all of the limitations of independent Claim 2, due to its dependency therefrom. Thus, as Claim 2 is non-obvious in view of *Woo* and the *Leitz Service Manual*, and further in view of *Yoshioka et al.* due to the missing elements, it necessarily follows that Claim 15 is also non-obvious in view of *Woo* and the *Leitz Service Manual*, and further in view of *Yoshioka et al.*, due to its dependency from Claim 2. Applicants request reconsideration and withdrawal of the rejection of Claim 15.

Conclusion

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,



Robert C. Atkinson
Attorney for Applicants
Registration No. 57,584
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

RCA/
Dated: June 18, 2007